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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,669	12/09/1999	TETSURO MOTOYAMA	5244-0117-2X	7939

7590 10/02/2002

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EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 10/02/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,669

Applicant(s)

MOTOYAMA, TETSURO

Examiner

B. PRIETO

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. DRAFTSPERSON.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This communication is in response to request for reconsideration files 07/18/02, claims 52-124 remain pending.

2. Quotation of the first paragraph of 35 U.S.C. 112 may be found in previous office action. Claim 77 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, claim limitation recites, storing, internally, status information of the business office device, it is unclear from the method claim where exactly is "internally".

Applicant has traversed this rejection on the basis that (i) Figs. 1-3 "disclose internal storage units" for the business office devices, and (ii) page 14 of the specification discloses using those storage devices to store "state/status information". However, Figs. 1-3, illustrate no label elements denoted "internal storage units", page 14, discloses not recitation of "state/status information". Arguments are not persuasive. Claim limitation is not clear, correct, and unambiguous, see MPEP 2106.

3. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

4. Claims 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089.

Regarding claim 52, Belinski teaches a business office device (11-28) which is connected to a (sending) monitoring device (12) that monitors the business office device response, the business office device comprising;

at least one memory (col 17/lines 41-47, storing sending/receiving information, col 3/lines 61-66, col 3/lines 7-12) for storing information to be communicated to the monitoring device communicated information, communicated information including sending an

electronic mail message to the monitoring device, monitoring the business office device response (col 4/lines 12-47),

an network controller (interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50);

however Beilinski business office device sending a request for status information of the coupled receiving business office device upon which the sending business office device monitors the receiving business office device for a response is not called a "monitoring device";

It would have been obvious to one ordinary skilled in the art at the time the invention was made to utilize Beilinski's teaching to execute claimed invention performing the same as claimed, motivation would be to enable detect the status condition of a business office device such as a printer or modem, improve existing prior art by enabling a peripheral device to send information back to another business office device such as a computer, sending mail messages that indicate the status of the receiving office device or sending an error message, as taught by Beilinski.

5. Claims 53-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089 in view of Tarr et. al. (Tarr) U.S. Patent No. 5,184,179.

Regarding claim 53, however the above-mentioned prior art does not explicitly teach communicating with the monitoring device via a telephone system and a modem;

Tarr teaches a business office device (52) transmit status information to the monitoring device (54) (col 3/lines 33-40, col 5/lines 2-30) via telephone system and modem (14), a memory (504, 506) for storing status information (Fig. 6, step 316) (col 3/lines 61-col 4/line 3, col 4/lines 60-67) status information including a multiple portions (col 3/lines 40-49).

It would have been obvious to one ordinary skilled in the art at the time the invention

was made to include means for the business office device transmits the status information to the monitoring device at a predetermined interval as taught by Tarr, into Beilinski system enabling the transmission of a first portion of status information, motivation would be improve existing monitoring system by implementing means for automatically notifying off-site parties at appropriate times of status of monitoring devices, as taught by Tarr.

Regarding claim 54, the email interface each can transmit one of the status information portions (Bielinski: col 6/lines 17-19 status information col 4/lines 12-47, col 12/lines 42-50) and direct connection-mode interface can transmit one of the status information portions (Tarr: col 3/lines 40-49).

Regarding claim 55, wherein the business office device transmits the first portion of the status information to the monitoring device at a predetermined interval (Tarr: col 3/lines 33-40, col 5/lines 2-30).

Regarding claim 56, event-driven transmission (in response to the receipt of a status message containing an error message (Tarr: col 6/lines 55-col 7/lines 3).

Regarding claims 57-58, persistent memory for storing an assigned identification number (name) of the business office device (Tarr: col 5/lines 37-49, col 10/lines 61-67) and communication to monitoring device from the business office device enable monitoring device to identify transmitting business office device (Tarr: col 5/lines 37-40).

Regarding claim 59-60, persistent memory storing the telephone number (address) of the business office device and communicating said address to the monitoring device (Tarr: col 5/lines 30-40).

Regarding claims 61-62, status information is transmitted by the email interface (Beilinski: col 6/lines 17-19, col 4/lines 12-47, col 12/lines 42-50), transmitting status information as an

email message, monitoring device polls business office device for status information (Tarr: col 6/lines 27-38).

Regarding claims 63-64, business office device is a printer (Tarr: col 2/lines 17-18), persistent memory storing option configuration (Tarr: col 9/lines 6-22).

Regarding claims 65-66, persistent memory stores a model and serial number (Tarr: col 5/lines 30-47).

Regarding claim 67, persistent memory stores characteristics of said business office device, which do not change over a life of said business office device (e.g. serial number discussed above).

Regarding claim 68, dynamic memory stores dynamic data (Tarr: col 3/lines 61-col 4/line 3).

Regarding claims 69, 71, 72, 73 and 75, dynamic memory stores an indication of a paper tray present in the business office device and indication of a status of paper in a paper tray present in the business office device (Tarr: col 3/lines 16-31, col 5/lines 60-col 6/line 2), an indication of consumable goods (e.g. oil), amount of toner, number of prints in the business office device (Tarr: col 5/lines 60-col 6/line 2).

Regarding claims 70 and 74, storing in a dynamic memory an indication of a voltage used (Tarr: col 8/lines 56-67) and an indication of a sensitivity of photoreceptor in the business office device (Tarr: col 5/lines 60-col 3/line 2).

Regarding claim 76, substantially the same as claim 52 and further the business office device and monitoring device discussed above are comprised in a business system (Tarr: col 10/lines 5-18) and said monitoring device is monitoring from a remote location (Tarr: col 3/lines 10-40).

Regarding claim 77, as discussed on claims 52 and 76, the monitoring device monitors the business office device from a remote location (Tarr: col 3/line 16-40), storing within the system, status information of the business office device (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claim 78, establish a direct connection mode via terminal-based interface (i.e. interface linked to a telephone system from the monitored business office device to the monitoring device through a modem, Tarr: col 3/lines 33-40, col 5/lines 2-30 via telephone system and modem for transmitting status information portion across said link (Tarr: col 11/lines 17-26, maintenance status information, col 5/lines 3-13, col 14/line 63-col 15/line 2).

Regarding claim 79, first and second portion of status information are stored in the same (one) memory (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claims 80-100 are the monitoring method associated with the business office device discussed on claim, and substantially, same rationale is applicable.

Regarding claims 101-124, this claim is the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for monitoring a business office device, the computer program code mechanism comprising the computer code configured to perform the method discussed on claims 77-100, same rationale is applicable.

Related U.S. Patents:

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with to MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

Ref A: U.S. 5,555,191 issue date 09/1996:

Hripesak teaches a method of automatically monitoring a system, detecting a malfunction of the system, where the system generates messages based on selected data, receiving and collecting the messaged from the system upon satisfying a predetermined criteria sending collected data by electronic mail to a system administrator.

Ref B: User Services Conference, Freund, W., ISBN: 0-89791-545-3, 1992, pages 101-103.

Freund teaches business office device such as PC or desktop configured for transmitting an e-mail messages supported by MHS-SMTP protocols part of the TCP/IP suite.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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(703) 746-7239, (for Official communications intended for entry)

Or:


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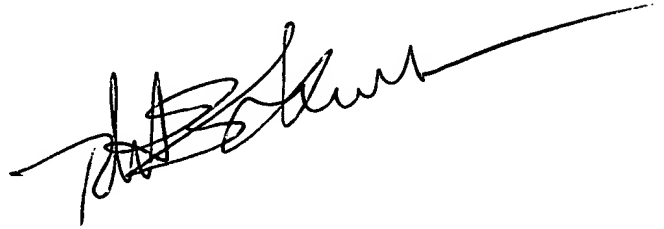
"PROPOSED"

or "DRAFT")

Art Unit: 2152

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".


B. Prieto
Patent Examiner
September 27, 2002



**ROBERT B. HARRELL
PRIMARY EXAMINER**